

2 MAY 1998 PCT/PTO 2 MAY 1998

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: Perricaudet et al. Group Art Unit:  
International Application No: PCT/FR96/00218  
Serial No.: 08/894,246 Examiner:  
Filing Date: August 14, 1997

For: Medicinal Combination Useful For In Vivo Exogenic Transfection and Expression

To: Assistant Commissioner for Patents  
Washington, D.C. 20231

**RECEIVED**

18 JUN 1998

Legal Staff  
International Division

CERTIFICATE OF MAILING (37 CFR 1.10)

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I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Commissioner of Patents and Trademarks, Box PCT, Washington, DC 20231.

Paula L. Dickey  
(Type or print name of person mailing paper)

*Paula L. Dickey*  
(Signature of person mailing paper)

PETITION UNDER 35 U.S.C. § 118 AND 37 C.F.R. § 1.47(a)

Dear Sir:

Applicants hereby petition for completing the requirements for filing the above-identified application under 35 U.S.C. § 371 and 37 C.F.R. § 1.63 with a Declaration executed by inventors MICHEL PERRICAUDET, LUCIENNE CHATENOU, HEDI HADDADA, JEAN-FRANCOIS BACH and MICHELLE WEBB on behalf of themselves and co-inventor MARTIN LEE, who refuses to execute the Declaration, under 35 U.S.C. § 118 and 37 C.F.R. §§ 1.47(a).

FACTS

The above-identified application was submitted on 14 August 1997 pursuant to 35 U.S.C. § 371(c)(1-3,5) as a National application of PCT International Application PCT/FR96/00281, filed 12 February 1996. The application was submitted without a

Declaration under 35 U.S.C. § 371 (c)(4). The Application is co-owned by Rhone-Poulenc Rorer, S.A. (RPR) and Institute Nationale de la Sante et de la Recherche Medicale (INSERM). The PCT International Application (and the French Priority Application, FR 95/01662, filed 12 June 1995) were filed by RPR's Patent Department in France.

Attorneys for Application (RPR's Patent Department in the US) received instructions from Rhône-Poulenc Rorer's Patent Department in France to file the National Application on 20 June 1997 by correspondence date 12 June 1997 (Exhibit A). Janet Shepherd, docket clerk for Attorneys for Applicants, forwarded a Declaration and Power of Attorney (Declaration) to the French Patent Department to be circulated to the inventors for execution (Exhibit B). Each of the inventors executed the Declaration and it was returned to Attorneys for Applicants by communication dated 14 October 1997 for filing with the National Stage Application (Exhibit C). However, upon review of the Declaration, Attorneys for Applicants observed that the Declarants had made changes to the address information without initialing and dating the changes. It was determined that a corrected Declaration should be provided to the inventors for execution. This action was taken on 10 December 1997 (Exhibit D). Applicants' attorneys received a Notice to File Missing Requirements Under 35 U.S.C. § 371 dated 1 December 1997.

On or about 24 March 1998, the undersigned Attorney for Applicants inquired from Roxane Dernoncour, a patent agent with the RPR Patent Department in France, about the status of the corrected Declaration and Power of Attorney. Ms. Dernoncour informed the undersigned Attorney that co-inventor Martin Lee refused to execute the corrected Declaration without payment.

On 24 March 1998, Ms. Dernoncour prepared a memorandum setting forth the facts in connection with Lee's refusal to execute the Declaration (Exhibit E). She stated that the Declaration, executed by four inventors, was forwarded to Mr. Lee on 29 January 1998 (see Exhibit E, Appendix I). She stated further that she requested that Mr. Lee execute and return the Declaration on 5 March 1998, and that on 6 March 1998 Mr. Lee stated that he would not execute the Declaration without remuneration. Upon Ms. Dernoncour's request, Mr. Lee faxed his request for 50,000

ff (approximately \$8500 US) for his signature on the Declaration (see Exhibit E, Appendix II). RPR refused and continues to refuse to pay this fee, as Lee's employment with Centre Nationale de Recherche Scientifique (CNRS) requires him to assign his inventions to CNRS, and to promise in all circumstances his cooperation with respect to the application and enforcement of any patents (see Appendix III to Exhibit E, Article 3, second paragraph). In accordance with a separate agreement between RPR and CNRS, Mr. Lee assigned his rights to the invention to RPR (Exhibit F).

On 2 April 1998, the undersigned Attorney contacted Mr. Lee by DHL courier to request that he execute the Declaration in accordance with his obligations, and informed Mr. Lee that Applicants would maintain the application if he refused to execute the Declaration (Exhibit G). A Declaration in accord with 37 C.F.R. § 1.47(a) was accordingly prepared and sent for execution by the other five co-inventors (see Exhibit H; the Declaration for execution by the inventors in France was sent to the French Patent Department by electronic mail). The undersigned Attorney spoke with Mr. Lee on 6 April 1998, and was informed by Mr. Lee that he would continue to refuse to execute the Declaration. A memorandum memorializing this conversation was prepared and placed in the Attorney's file on 13 April 1998 (Exhibit I).

All five co-inventors executed the Declaration on behalf of themselves and Martin Lee. The executed Declaration is submitted herewith.

The last known address of Martin Lee is 64 Princes Street, Oxford, OX4 1DE, ENGLAND.

#### PETITION

In view of the foregoing facts, Applicants request that the present application be regarded as complete under 35 U.S.C. § 115 and 37 C.F.R. §§ 1.63 and 1.64 pursuant to 35 U.S.C. § 118 and 37 C.F.R. § 1.47(a). Granting of this petition is necessary to preserve the parties rights and to prevent irreparable damage to Applicants, which would occur if the Application were to be abandoned.

Authorization to charge Attorneys' deposit account for the cost of this petition is found in the Fee Transmittal submitted herewith. In the event that the fee

transmittal is separated from this Petition, authorization is hereby given to charge Attorney Deposit Account No. 18-1982 for all fees in connection therewith.

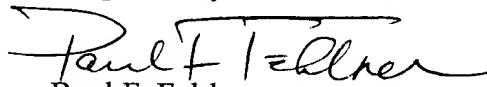
PRAYER FOR RELIEF

Applicants and Applicants' assignees, RPR and INSERM, pray for grant of this petition. This action is necessary to preserve the rights of the parties and to prevent irreparable damage. Early and favorable action on this Petition is earnestly solicited.

Rhone-Poulenc Rorer Inc.  
P.O. Box 5093, Mail Stop 3C43  
Collegeville, PA 19426-0997  
Telephone: (610) 454-3839  
Facsimile: (610) 454-3808

Dated: 5/22/98

Respectfully submitted,



Paul F. Fehlner

Attorney for Applicants  
Registration No. 35,135